



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 182

Date of Decision: 2023-10-30

IN THE MATTER OF SECTION 45 PROCEEDINGS

Requesting Party: Miller Thomson LLP

Registered Owner: BEHAVIOUR INC.

Registrations: TMA873,050 for BEHAVIOUR, and
TMA873,051 for BEHAVIOUR & DESIGN

INTRODUCTION

[1] This is a decision involving summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA873,050 for the trademark BEHAVIOUR (the Word Mark) and TMA873,051 for the trademark BEHAVIOUR & Design (the Design Mark), collectively referred to as the Marks.

[2] The Marks are registered for use in association with the following services:

Business management consultation services provided to businesses and charitable organizations in the fields of sponsorships, digital or social media design and execution, brand design and creation, public relations, consumer and market research, the design and implementation of strategy plans and management projects, marketing activities and

the launching of new brands and products, and interior retail space and merchandise display design.

[3] For the reasons below, I conclude that both registrations should be maintained.

PROCEEDING

[4] At the request of Miller Thomson LLP (the Requesting Party), the Registrar of Trademarks issued notices under section 45 of the Act on December 23, 2021, to the registered owner of the Marks, Behaviour Inc. (the Owner).

[5] The notices required the Owner to show whether the Marks were used in Canada in association with each of the services specified in the registrations at any time within the three-year period immediately preceding the date of the notices and, if not, the date when they were last in use and the reason for the absence of use since that date. In both cases, the relevant period for showing use is from December 23, 2018, to December 23, 2021.

[6] The relevant definition of “use” in the present case is set out in section 4 of the Act as follows:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] Where the owner has not shown “use”, a registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] The purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. The evidence in a section 45 proceeding need not be perfect; the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[9] In response to each notice, the Owner furnished the affidavit of Scott O’Hara, its founder and CEO.

[10] Only the Owner submitted written representations and attended an oral hearing.

ANALYSIS AND REASONS FOR DECISION

[11] The affidavits of Mr. O'Hara filed in the proceedings are substantially identical, except for the identification of the trademark at issue. In his evidence pertaining to the Relevant Period, Mr. O'Hara provides:

- (a) a detailed description of the services in each field listed in the registrations along with specific examples of such services offered to clients [paras 9-10];
- (b) specific examples of Canadian clients, businesses, and charitable organizations alike, to whom the Owner has provided services [paras 12-13];
- (c) numerous examples of how the Design Mark was displayed to actual and potential clients during the performance and advertising of the services, including:
 - i. Business forms and materials used in the performance of the services such as invoices, purchase order forms, stationery, cheques, and email signatures [para 16, Exhibit 3];
 - ii. External public facing signage at the Owner's normal place of business [para 24, Exhibit 7];
 - iii. Promotional items distributed to clients and potential clients [para 15, Exhibit 2];
 - iv. Representative examples of the Owner's website and LinkedIn pages, including visits and follower information [paras 18-20, Exhibit 4];
 - v. Representative examples of various promotional events hosted or sponsored by the Owner [para 21, Exhibit 5];

(d) A statement that revenues generated from the performance of the services were well in excess of hundreds of thousands of dollars per year [para 26].

[12] Mr. O'Hara's evidence clearly demonstrates ubiquitous display of the Design Mark during the Relevant Period.

[13] I note that certain items show only the stylized version of the word BEHAVIOUR from the Design Mark. Also, the quality of some of the images in Mr. O'Hara's evidence makes it difficult to clearly see the finer graphic details of the Design Mark. That being said, the Design Mark as registered can be made out in at least one of each example provided.

[14] In any event, I find the dominant feature of the Design Mark to be the stylized version of the word BEHAVIOUR, such that the trademark, even if used without the finer graphic details, retained its identity, and remained recognizable. Use of the stylized word therefore constitutes use of the Design Mark as registered [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc*, 1992 CanLII 12831, 44 CPR (3d) 59 (FCA); *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265].

[15] With regard to use of the Word Mark, it is well established that a registration for a word mark can be supported by use of that mark in any stylized form and in any colour [*Brouillette & Associés v Constellation Brands US Operations, Inc*, 2016 TMOB 159]. In the present case, I find that use of the Design Mark, and more particularly its dominant feature, the stylized word BEHAVIOUR, also constitutes use of the Word Mark [see *Conergy AG v ATCO Electric Ltd*, 2013 TMOB 139 at paras 17-20 for a similar conclusion].

[16] As such, Mr. O'Hara's evidence clearly shows the Marks on materials that were distributed and used during the performance and advertising of all of the registered services in Canada during the Relevant Period. I am therefore satisfied that the Owner

has demonstrated use of the Marks within the meaning of sections 4 and 45 of the Act in association with all the services in the registrations.

DISPOSITION

[17] Pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, registration No. TMA873,050 for the trademark BEHAVIOUR and registration No. TMA873,051 for the trademark BEHAVIOUR & Design will both be maintained in their entirety.

Emilie Dubreuil
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-09-28

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Colleen Spring Zimmerman

AGENTS OF RECORD

For the Requesting Party: Miller Thomson LLP

For the Registered Owner: Fogler, Rubinoff LLP